

REMARKS

Status of the Application

Claims 1-26 are pending in the application. Claims 1-4, 11, 15-17, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton (US Patent 7,179,232) in view of Twersky (US Patent 4,445,788). Claims 5-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 4 above, and further in view of Juhn (US Patent 4,641,663). Claims 7 and 12-19 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Sutton in view of Twersky as applied to claim 1 and 11 above, and further in view of Shapira (US Patent 6,110,176). Claims 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 1 above, and further in view of Morawski (US Publication 2004/0010236). Claims 24-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 1 above, and further in view of Gauthier (US Patent 4,256,119).

Preliminary Matters

Applicants thank the Examiner for accepting the drawings filed on April 27, 2006.

Applicants further thank the Examiner for acknowledging the claim for foreign priority and confirming receipt of the certified copy of the priority document.

Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 11, 15-17, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton (US Patent 7,179,232) in view of Twersky (US Patent 4,445,788).

The Examiner provides the same basic rejection of claim 1 as was provided in the previous Office Action dated December 23, 2008. Therefore, the following comments will be

mainly directed toward the Examiner's Response to Arguments found on pages 10-11 of the instant Office Action.

On page 11 of the Office Action, in order to support combination of Sutton and Twersky, the Examiner states: "it is well known that bone marrow sampling is a method of coring material, thus one of ordinary skill in the art would have motivation to search any field regarding coring of a material using a needle or probe such as soil coring". Applicants respectfully disagree.

The Examiner alleges that Sutton and Twersky do not teach away from each other because Sutton discloses that the openings on an inner shaft may be selectively aligned with openings on an outer shaft, which inherently allows for closing of some of the openings. However, claim 1 requires that a protective sleeve be held in a closed position or an open position. Sutton, on the other hand, requires that the inner cannula shaft and outer cannula shaft must be movable in order to allow bone marrow to be extracted from multiple places without needing to reposition the outer cannula shaft. If Sutton were modified as proposed by the Examiner, the usefulness of being able to quickly realign the inner cannula and outer cannula shaft would be compromised. Therefore, Sutton does indeed teach away from modification as proposed by the Examiner.

Further, the device recited in claim 1 is a medical device used during surgery. The device is used for extracting and/or injecting material from/to a site located inside a human body. On one hand, Sutton relates to a medical device, while, on the other hand, Twersky's soil probe is a sensor-like device, where **no material is extracted or injected**. The fact that Sutton penetrates a bone and that Twersky's soil probe penetrates the soil does not support the argument that the devices would be easily combinable. Although the devices in both Sutton and Twersky allegedly share a single common feature (in this case, penetration of a substance), the alleged common

feature is insufficient by itself to establish that it would have been obvious for one of ordinary skill in the art to choose to modify the primary reference with a single feature from the secondary reference. This is especially true when the proposed modification would inhibit the functionality of the primary reference, as noted above.

The skilled person of the invention is a specialist of bone-marrow sampling devices. This person has no motivation to search for a technical solution related to bone-marrow devices in the field of soil probes, especially when there is no need for the solution proposed by the Examiner. Thus, Applicants submit that Sutton and Twersky cannot be combined as alleged by the Examiner.

Therefore, claim 1 is patentable over the Examiner's proposed combination of references. Claims 2-4, 11 and 15-17 depend from claim 1 and are patentable at least by virtue of their dependency therefrom.

Claims 5-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 4 above, and further in view of Juhn (US Patent 4,641,663).

Claims 5 and 6 depend from claim 1. Because the Examiner's proposed combination of Sutton and Twersky fails to render claim 1 obvious, and because Juhn fails to cure the deficiencies noted with respect to claim 1, claims 5 and 6 are patentable over the applied art.

Claims 7 and 12-19 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Sutton in view of Twersky as applied to claim 1 and 11 above, and further in view of Shapira (US Patent 6,110,176).

Claims 7 and 12-19 depend from claim 1. Because the Examiner's proposed combination of Sutton and Twersky fail to render claim 1 obvious, and because Shapira fails to cure the

deficiencies noted with respect to claim 1, claims 7 and 12-19 are patentable at least by virtue of their dependency.

Furthermore, Applicants submit that the Examiner's interpretation of Shapira is misplaced.

According to the Examiner, Shapira discloses a mixing chamber in the apparatus wherein an infusion fluid is mixed with extracted bone marrow. In reality, this irrigation fluid is directly injected in the bone, where it mixes with the bone-marrow (see col. 6, l. 63-67). There is no mixing chamber in the apparatus where a fluid could be mixed with bone-marrow already collected from the extraction site. Obviously, the irrigation fluid of Shapira could not be replaced by anticoagulant, which can not be injected directly in a bone. Thus, the mixing with anticoagulant is provided by Shapira after extraction of bone-marrow, outside the apparatus. It would not be obvious to modify Sutton and Twersky with Shapira's device, and a combination of Shapira with Sutton and Twersky thus does not render these claims obvious.

Claims 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 1 above, and further in view of Morawski (US Publication 2004/0010236).

Claims 20-22 depend from claim 1. Because the Examiner's proposed combination of Sutton and Twersky fails to render claim 1 obvious, and because Morawski fails to cure the deficiencies noted with respect to claim 1, claims 20-22 are patentable over the applied art.

Claims 24-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sutton in view of Twersky as applied to claim 1 above, and further in view of Gauthier (US Patent 4,256,119).

Claims 24 and 25 depend from claim 1. Because the Examiner's proposed combination of Sutton and Twersky fails to render claim 1 obvious, and because Gauthier fails to cure the deficiencies noted with respect to claim 1, claims 24 and 25 are patentable over the applied art.

Claim 26 recites features similar to claim 1, and is patentable for reasons analogous thereto, as Gauthier fails to cure the deficiencies noted with respect to the Examiner's proposed combination of Sutton and Twersky.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Dion R. Ferguson/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: October 20, 2009

Dion R. Ferguson
Registration No. 59,561